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10/022,153	12/14/2001	Steven W. Lundberg	684.001US2	5885

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. BOX 2938  
MINNEAPOLIS, MN 55402

EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/022,153

Applicant(s)

LUNDBERG, STEVEN W.

Examiner

Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/14/2001.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-20 are presented for examination.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 5, 6, 8, 10-13, 15, 16, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egendorf, Pat. No. 5,794,221 in view of Brendzel, Pat. No. 5,950,174.

As a preliminary matter, the Examiner notes that the term "patent and trademark fees" will not be given any patentable weight in the independent claims since the term is only found in the preamble. The preamble is not given the effect of a limitation unless it breathes life and meaning by the claim (see MPEP Section 2111.02). The term "patent and trademark fees" merely describes the purpose of claimed method.

Furthermore, the clause "wherein the agency comprises a patent or patent and trademark agency" is non functional descriptive language or material and does not impart a patentable distinction over the prior art and will not be given the effect of a limitation.

As to claim 1, Egendorf discloses a computerized method for managing fees (see abstract) comprising:

inputting identification information for a matter of a client of a firm (i.e. customer) and a requested fee associated with the matter for payment to an agency as data representing the identification information (i.e. vendors 8.1 who are connected directly to the Internet via access network 7 and provider 9 to bill customers 4.1 for services purchased by them over the Internet. The exchange of information may include identifying information relating to the customer relating to the products or services being purchased)(col. 4, line 57 - col. 5, line 7 and lines 18-27);

issuing a charge for the requested fee at the computer workstation for transmittal to the agency (i.e. the customer can specify a particular billing account)(col. 6, lines 13-35);

transmitting electronically data representing first information regarding the charge for the requested fee from the computer workstation to a fee computer system maintained by the organization (col. 5, lines 18-35);

inputting second information regarding the charge received from an external source as data representing the second information into the fee computer system (i.e. Provider 2 can then send verifying information to one or both of the customer and vendor to indicate that the transaction has been approved)(col. 5, lines 35-37); and,

reconciling electronically the data representing the first information regarding the charge with the data representing the second information regarding the charge at the fee computer system (i.e. Provider 2 can then send verifying information to one or both

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of the customer and vendor to indicate that the transaction has been approved)(col. 5, lines 35-37).

Egendorff does not explicitly disclose

the charge payable against an account maintained by an organization separate from the firm.

However, Brendzel disclose a system that permits a customer (i.e. firm) to charge against an account maintained by an organization separate from the customer (i.e. a party is willing to serve as a financial surrogate for some subscribers of a service provider)(see abstract). Parties are willing to act as financial surrogates for customers to provide savings by sending bills for charges accrued by the subscribers directly to the surrogate where the surrogate pays the bills and makes its own arrangements with the subscribers to be appropriately compensated (col. 1, lines 19-22). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the charge payable against an account maintained by an organization separate from the firm within the Egendorff system in order to provide savings by sending bills for charges accrued by the subscribers directly to the surrogate where the surrogate pays the bills and makes its own arrangements with the subscribers to be appropriately compensated(col. 1, lines 19-22).

As to claim 5, Egendorff discloses the computerized method of claim 1, wherein the account maintained by the organization is a deposit account with the agency, and issuing a charge for the requested fee at the computer workstation comprises

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generating an authorization for debit of the requested fee from the account (i.e. telephone account or on-line services account. Transactions will be billed to that account)(col. 6, lines 13-24).

As to claim 6, Egendorff discloses the computerized method of claim 5, wherein the external source comprises a statement received from the agency regarding transactions regarding the account, the transactions including debits made from the account (i.e. the provider can send verifying information to the customer)(col. 5, lines 35-39) .

As to claim 7, Egendorff does not explicitly disclose the computerized method of claim 2, wherein generating data representing a fee invoice including the charge at the computer workstation also comprises printing a paper copy of the data representing the fee invoice on a printer operatively coupled to the computer workstation.

However, the Examiner takes official notice that it was well known in the computer arts to print transactional information at a printer. This allows a user to maintain a hardcopy record of transactional information entered at a computer workstation. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the computerized method of claim 2, wherein generating data representing a fee invoice including the charge at the computer workstation also comprises printing a paper copy of the data representing the fee invoice on a printer operatively coupled to the computer workstation within the

Egendorff system in order to allow a user to maintain a hardcopy record of transactional information entered at a computer workstation.

As to claim 8, Egendorff discloses the computerized method of claim 1, wherein the first information and the second information each include the amount of the requested fee (i.e. The exchange of information may include identifying information relating to the customer relating to the products or services being purchased)(col. 4, line 57 - col. 5, line 7 and lines 18-27).

As to claim 10, Egendorff discloses the computerized method of claim 1, wherein the computer workstation comprises a computer of a network of a plurality of computers (i.e. Internet)(col. 4, lines 57-65).

As to claim 11, Egendorff discloses the computerized method of claim 2, wherein the accounting computer system comprises a computer of a network of a plurality of computers (i.e. Internet)(col. 4, lines 57-65).

As to claim 12, Egendorff does not explicitly disclose the computerized method of claim 1, wherein the data representing first information regarding the charge for the requested fee is transmitted electronically from the computer workstation to the fee computer system daily.

However, the Examiner takes official notice that it was well known in the computer arts to batch multiple communications. The purpose of batching the communications is to send the plurality of communications during off peak times to reduce the communications costs associated with electronic transmissions. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the computerized method of claim 1, wherein the data representing first information regarding the charge for the requested fee is transmitted electronically from the computer workstation to the fee computer system daily within the Egendorff system for the motivation stated above.

As to claim 13, the computerized method of claim 1, wherein the data representing the fee invoice including the charge is transmitted to the accounting computer system monthly.

However, the Examiner takes official notice that it was well known in the electronic billing arts to transmit charges on a monthly basis. The purpose is to emulate traditional billing cycles and to provide convenient billing to customers. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the computerized method of claim 1, wherein the data representing the fee invoice including the charge is transmitted to the accounting computer system monthly within the Egendorff system for the motivation stated above.



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As to claim 15, Egendorff discloses the computerized method of claim 1, wherein the agency comprises a foreign associate firm (i.e. vendor that provides services)(col. 5, lines 1-5).

As to claim 16, Egendorff discloses a computerized method for managing fees comprising:

inputting identification information for a matter of a client of a firm and a requested fee associated with the matter for payment to an agency as data representing the identification information into a computer workstation (i.e. vendors 8.1 who are connected directly to the Internet via access network 7 and provider 9 to bill customers 4.1 for services purchased by them over the Internet. The exchange of information may include identifying information relating to the customer relating to the products or services being purchased)(col. 4, line 57 - col. 5, line 7 and lines 18-27);

transmitting electronically data representing first information regarding a charge for the requested fee from the computer workstation to a fee computer system maintained by an organization, to request permission to issue the charge for the requested fee at the workstation (col. 5, lines 18-35);

issuing the charge for the requested fee for transmittal to the agency at the computer workstation upon receiving approval from the fee computer system, the charge payable against an account maintained by the organization (i.e. Provider can send verifying information to one or both of the customer and vendor to indicate the

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transaction has been approved. The appropriate customer account is billed and the provider then remits the agreed payment to the vendor)(col. 5, lines 30-49);

inputting second information regarding the charge received from an external source as data representing the second information into the fee computer system (i.e. Provider 2 can then send verifying information to one or both of the customer and vendor to indicate that the transaction has been approved)(col. 5, lines 35-37); and

reconciling electronically the data representing the first information regarding the charge with the data representing the second information regarding the charge at the fee computer system (i.e. Provider 2 can then send verifying information to one or both of the customer and vendor to indicate that the transaction has been approved)(col. 5, lines 35-37).

Egendorff does not explicitly disclose

A charge for the requested fee from the computer workstation to a fee computer system maintained by an organization separate from the firm.

However, Brendzel disclose a system that permits a customer (i.e. firm) to charge against an account maintained by an organization separate from the customer (i.e. a party is willing to serve as a financial surrogate for some subscribers of a service provider)(see abstract). Parties are willing to act as financial surrogates for customers to provide savings by sending bills for charges accrued by the subscribers directly to the surrogate where the surrogate pays the bills and makes its own arrangements with the subscribers to be appropriately compensated (col. 1, lines 19-22). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include a

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charge for the requested fee from the computer workstation to a fee computer system maintained by an organization separate from the firm within the Egendorff system in order to provide savings by sending bills for charges accrued by the subscribers directly to the surrogate where the surrogate pays the bills and makes its own arrangements with the subscribers to be appropriately compensated (col. 1, lines 19-22).

As to claim 19, Egendorff discloses the computerized method of claim 16, wherein the account maintained by organization is a deposit account with the agency, and issuing a charge for the requested fee at the computer workstation comprises generating an authorization for debit of the requested fee from the account (i.e. telephone account or on-line services account. Transactions will be billed to that account)(col. 6, lines 13-24)..

As to claim 20, Egendorff discloses the computerized method of claim 16, wherein the first information and the second information each include the amount of the requested fee (i.e. The exchange of information may include identifying information relating to the customer relating to the products or services being purchased)(col. 4, line 57 - col. 5, line 7 and lines 18-27).

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4. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egendorff and Brendzel as applied to claim 1 above, and further in view of Pollin, Pat. No. 6,041,315.

As to claim 3, Egendorff discloses the computerized method of claim 1, wherein the account maintained by the organization is an account with a financial institution (i.e. the customer may specify a particular account such as a bank account)(col. 6, lines 13-18).

Egendorff does not explicitly disclose

issuing a charge for the requested fee at the computer workstation comprises printing a check for the requested fee payable against the account maintained by the organization on a printer operatively coupled to the computer workstation for delivery to the agency.

However, Pollin discloses issuing a charge for the requested fee at the computer workstation comprises printing a check for the requested fee payable against the account maintained by the organization on a printer operatively coupled to the computer workstation for delivery to the agency (col. 12, lines 33-50). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include issuing a charge for the requested fee at the computer workstation comprises printing a check for the requested fee payable against the account maintained by the organization on a printer operatively coupled to the computer workstation for delivery to the agency within the Egendorff and Brendzel combination in order

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to collect payments using an automated draft printing system operated by an authorized agent (col. 3, lines 57-60).

As to claim 4, Egendorff discloses the computerized method of claim 3, wherein the external source comprises a statement received from the financial institution regarding transactions regarding the account, the transactions including checks drawn against the account (i.e. when the transactional information is communicated, it will include an indication of which of the plurality of billing accounts the customer wants billed)(col. 6, lines 28-36)

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Egendorff and Brendzel as applied to claim 16 above, and further in view of Pollin.

As to claim 18, the claim is similar in scope to claim 3 above and is rejected for the same reasons.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,363,361. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant application are broader than the claims in the '361 patent.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Pat. No. 5,247,575 discloses an information distribution system with billing and accounting components.

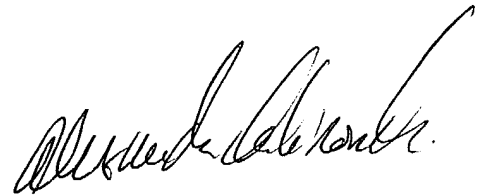
b. Pat. No. 6,192,407 discloses directed document delivery system with billing.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

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If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.

A handwritten signature in black ink, appearing to read "Alexander Kalinowski", with a stylized, cursive script.

Alexander Kalinowski

Primary Examiner

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6/25/2004